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REMARKS

In view of the amendments presented herein, claims 1, 2, 16, 18-27, 30-31 and 44-71 are pending in this application. Dependent claims 3-15, 17-21, 28, 29 and 32-43 have been canceled by this response, these dependent claims being replaced by new dependent claims 44-71. Claims 1, 22, and 30 have been represented without amendment while amendments have been presented to independent claims 16, 24 and 31.

The amendments presented herein are presented to adjust the claim scope to applicants' current commercial embodiments and are not presented to distinguish over the cited prior art for reasons that are clear from a review of the substantive response to the outstanding Office Action.

The Abstract has been amended to place it in single paragraph form as suggested by the Examiner in the outstanding Office Action.

Applicants respectfully note the Examiner's acknowledgement of the claim for priority as well as the receipt of all priority applications.

The Subject Matter of the Present Application

Prior to discussing the substantive rejections issued by the Examiner, applicants would first like to briefly explain the present invention in the light of its field of application. The present invention is generally directed to a class of input devices which use a sensor, typically a hand-held sensor, to read a pattern, in this case, a position coding pattern provided on a surface by printing, embossing or another form of affixing a pattern readable by the sensor. An example of this position coding pattern is

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illustrated in Fig. 1 of the present application as a series of dots which uniquely describe position.

Through the use of the input device or sensor, the position coding pattern, in the embodiment of Fig. 1, a series of dots, may be read to determine position of the sensor pattern. This sensor position may then be used for a variety of purposes. In accordance with the teachings of the present application, the sensor position may be used to record pen strokes, or "writing" through reading the successive positions of the input device to produce a pen path. Alternatively, the position pattern may be used to signal the actuation of a virtual function key or the like, by reading the position pattern and mapping it to a desired function.

The term position-coding pattern refers to a pattern which represents position through a code provided within the pattern. For example, in accordance with the teachings of the present application, the input unit 300 may be used to read the dots D to determine the position of these dots, thereby determining the position to which the hand-held input device is placed.

The Rejections

The Examiner has rejected claim 30 under §102(e) as being anticipated by the Seybold patent (USP 6,128,007). This rejection is respectfully traversed for the following reasons.

Claim 30 of the application requires the use of an absolute position coding pattern in order to cause an input unit arrangement to switch from a first function to second function. The Seybold reference does not disclose any form, whatsoever, of a

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position-coding pattern, much less an absolute position coding pattern. As already mentioned in the present response, a position-coding pattern is a pattern which codes position. An absolute position coding pattern is a pattern which codes position unambiguously providing absolute position, as compared to, for example, relative position. The Seybold reference discloses a pen type product which utilizes a pressure sensitive layer to sense stylus position on the writing surface, thereby unambiguously determining pen position. However, this a sensor system, which does not utilize any form of position-coding pattern as expressly recited in independent claim 30. The Seybold reference recognizes that digitizing tablets are known for entering handwritten information.¹

As alternatives, the Seybold reference suggests possibility of use of the stylus of Figs. 13 and 14. The stylus of Fig. 13 utilizes a permanent magnet at the end of the styles which is sensed by the display surface using "convention techniques in field sensing tablets."²

Since the Seybold reference fails to disclose the use of any absolute position-coding pattern as recited in claim 30, the Seybold reference cannot anticipate this claim.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631; 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since the Examiner fails to disclose the use of any absolute position coding pattern within the Seybold reference, this reference cannot anticipate

¹ '007 patent, col. 3, ll 13-15.

² '007 patent, col. 5, ll. 36-41.

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claim 30. The Examiner is accordingly requested to reconsider withdrawal of this rejection.

The Examiner has applied Seybold and Rabin to reject claims 1-4, 10-20, 22, 23, 31-34, 36-40, 42 and 43. This rejection is respectfully traversed for the following reasons.

The deficiencies of the Seybold reference have been noted above. The Examiner attempts to combine the Rabin reference to supplement the Seybold reference to allegedly teach the limitations of the above-mentioned claims. However, the Examiner has not set forth a *prima facie* case to support his rejection combination.

The Rabin reference is only even arguably applicable as a reference against the present application under 35 U.S.C. §102(e). No other subsection of Section 102 can be used by the Examiner. Under §102(e), Rabin is a statutory reference only if the subject matter relied on in Rabin is fully disclosed in the provisional application 60/186,866, filed on March 3, 2000 and relied on under §119(e) as the effective application date of the Rabin patent. This is because the application date of the present application, even without considering the priority under various parts of Sections 119 is February 16, 2001 which is before the filing date of March 2, 2001 of Rabin unless Rabin is entitled to the effective filing date of provisional application 60/186,866 filed March 3, 2000. See, for example, MPEP §706.02, page 721 of revision I, February 2003, section entitled "Determining the effective filing date of an application, subparagraph (D). This section makes it clear that a provisional application is effective to establish an effective filing date only "for any claims which are fully supported under the first paragraph of 35

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U.S.C. §112 by the provisional application." Since the Rabin reference is a statutory reference under §102(e) only to the extent that it has an effective application date prior to the effective invention date of the present application, the Rabin reference is a reference against the present application only if the Rabin provisional application supports the present claims.

The Examiner of a U.S. application has the burden to establish a *prima facie* case of obviousness. This *prima facie* case of obviousness includes the demonstration that each element of the claimed combination was present in the prior art and that, once multiple references are used, there is a motivation to combine these references. In the instant matter, the Examiner has not met his burden of proof with respect to these claims since the Rabin reference has not been shown a statutory reference against applicants, since the Examiner has demonstrated no content of the priority application under §119(e). It should be noted here that provisional applications are often used to develop an invention and often vary materially in disclosure from the disclosure of the later utility application. In the absence of a showing that the features are present in the provisional application disclosure, the effective application date of Rabin can be no later than March 2, 2001, thereby preventing this application from being considered a reference against applicants' invention. The requirement that the Examiner establish a *prima facie* case should be particularly true here where the Examiner has easy access to the content of the provisional application, access significantly more difficult for the present applicant.

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In the event the Rabin reference is shown to be a reference against the present application, applicants will swear behind this reference by perfecting applicants' priority claim to produce a date of invention of Feb. 18, 2000. Each of the independent claims of the present application are supported in the first Swedish priority application and thus have an effective filing date of February 18, 2000, before the provisional date of March 3, 2000 of the Rabin reference.

The Examiner has rejected claims 11, 21, and 35 as being unpatentable over Seybold in view of Rabin, further in view of the Hamamura patent (USP 6,567,120). This rejection is similarly deficient for the reasons set forth above with respect to the Seybold in view of Rabin rejection combination. Since one of the references applied by the Examiner is not shown to be a statutory reference and the other references do not employ a position coding pattern, this rejection fails to present a *prima facie* case of obviousness.

With respect to the remaining rejections, the Examiner has rejected claims 24-28 as being unpatentable by the Du reference. This rejection is respectfully traversed for the following reasons.

The Du reference, once again, is directed to a touch pad sensing device which does not employ a position coding pattern as already explained above with respect to the Seybold and Hamamura references. Accordingly, the Du reference fails to disclose the claims of the present application which all recite such a pattern. Accordingly, the Examiner's rejection of claims 24-26 based on the Du reference is inappropriate for the reasons expressed herein.

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The Examiner has rejected claim 29 as being unpatentable over Du in view of Hamamura. The Hamamura reference is similarly directed to a touch display and does not use position coding patterns as set forth in the claims. Consequently, the Examiner cannot make a *prima facie* case against the claims of the present application.

For all of the above stated reasons, reconsideration and withdrawal of all outstanding rejections is earnestly solicited. Favorable action and allowance of all claims is also believed appropriate.

Since the Examiner's primary rejection combination is ineffective through failure to show a *prima facie* case of obviousness, it is clear that the amendments presented to the attached claims are not necessitated by the outstanding rejection and were not made for the purposes of establishing patentability. Instead, these amendments were presented to this response for the purpose of better corresponding the claims to commercial embodiments being developed by applicants.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Michael K. Mutter (Reg. No. 29,680) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for

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any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Michael K. Mutter, #29,680

MKM/brsd
3782-0176P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

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